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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,539	07/22/2002	Heinrich Gers-Barlag	Beiersdorf 759-HCL	6360
7590 10/02/2003				
Norris McLaughlin & Marcus 30th Floor 220 East 42nd Street New York, NY 10017			EXAMINER YU, GINA C	
			ART UNIT 1617	PAPER NUMBER

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

10/031,539

Applicant(s)

GERS-BARLAG ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Claim Objections***

Claims 1 and 12 are objected to because of the following informalities: there is a typographical error in reciting the term "flavonoids [sic]". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gers-Barlag (WO 98/42300) in view of Msika (US 5939054) and Plaschke (US 6409996 B1).

Gers-Barlag teaches an emulsifier-free oil-in-water cosmetic composition comprising an oil phase, a water phase, and one or more types of micronized, inorganic metal oxides having amphiphilic properties, and other cosmetic additives. See abstract.

Gers-Barlag fails to teach phyllosilicate and flavones, flavonoids, or flavanones.

Msika teaches water-in-oil sunscreens comprising titanium and/or zinc oxide particles. The reference teaches that no additional emulsifiers are added. See col. 2, lines 1 –9. The reference teaches using a modified phyllosilicate, montmorillonites of the bentone for stabilizing the composition, and shows a formulation comprising 0.1-5 % by weight of Bentone 38. See col. 3, lines 49 –55; col. 4, lines 24 – 30; col. 9, line 55 – col. 10, line 14. See instant claims 4 and 11. 11The example shown in col. 8, lines 50 – 66 shows using alpha-tocopherol acetate, an antioxidant, by 0.5 % by weight, and further teaches that flavonoids also can be used as an antioxidant. See col. 5, lines 41 – 46. See instant claims 5 and 12. The reference teaches using titanium dioxide treated with alkylsilane or aluminum hydroxide and stearic acid. See instant claims 2, lines 1 – 37. The reference teaches the mean particle size of the titanium oxide particle is 20 nm, and the zinc oxide particles, 60 nm. See col. 2, lines 30 – 37.

Msika fail to provide specific motivation to select flavonoids as the antioxidant.

Plaschke teaches a flavonoid-containing sunscreen composition. See abstract. The invention is said to provide optimized UV-absorption profile. See col. 2, line 21 – col. 4, line 62.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Gers-Barlag by adding the phyllosilicate as motivated by Msika because of an expectation of successfully producing a stable emulsion. The skilled artisan would have been motivated to further add flavonoid as motivated by Plaschke because of an expectation of successfully producing a cosmetic composition with good UV protection.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, and 7-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6592883 B1 in view of U.S. Patent No. 5952391.

The '883 patent claims a finely dispersed water-in-oil system comprising an oil phase, water phase, amphiphile modified phyllosilicate and boron nitride, at most 0.5 % of emulsifiers, and optionally cosmetic or pharmaceutical additives such as UV light filter and antioxidant. See '883 patent, claim 1. While the '883 patent fails to teach flavones

or flavonoid, the '391 patent claims using flavones in cosmetic compositions to stabilize a UV light filter.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the claimed invention of '883 by adding the UV light filter and the stabilizers, flavones, as motivated by the '391 patent, because of an expectation of successfully producing a stable cosmetic composition comprising the UV light filter.


Although the conflicting claims of the instant claims and US Pat. No. 6592883 B1 are not identical, they are not patentably distinct from each other for above reason.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

  
**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**

9/30/03

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Gina C. Yu  
Patent Examiner